

### **REMARKS/ARGUMENTS**

This Amendment is submitted in response to the Office Action mailed on October 13, 2004. In the Office Action, claims 1, 3-13, 16-18, 21, 24, 27-30 and 32-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,453,535 issued to Nicholas (herein "Nicholas") in view of U.S. Patent No. 6,017,058 issued to Ross (herein "Ross"). Further, claims 14, 20, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholas in view of Ross and in further view of U.S. Patent No. 5,499,842 issued to Yamamoto *et al.* (herein "Yamamoto").

The present paper responds to the rejections made by the Examiner. In view of these remarks, reconsideration and allowance of all of the pending claims is respectfully requested.

### **APPROPRIATENESS OF MAKING THE OFFICE ACTION "FINAL"**

Although the Examiner issued a new rejection, the Examiner still made the present Office Action "final." See Office Action Cover Page. According to the MPEP, an Office Action in which the examiner introduces a new ground of rejection should not be final unless the new ground of rejection was "necessitated by applicant's *amendment of the claims*." MPEP 706.07(a) (*italics added*). In the prior Office Action response, Applicants' only claim amendments were to eliminate an unnecessary use of the word "and" in claims 21 and 30. These amendments were simply changes to the form of the claims and had nothing to do with the merits of the case, nor did it necessitate the new grounds of rejection. On the contrary, the new grounds of rejection were asserted by the Examiner in response to Applicants' submission of a declaration signed by the inventor. Therefore, Applicants submit that under the policies outlined by the MPEP, there was no basis for making the present Office Action final. Appropriate correction is respectfully requested.

### **REJECTION OF CLAIMS 1, 3-13, 16-18, 21, 24, 27-30 AND 32-34 UNDER §103(a)**

As outlined above, the Office Action rejected claims 1, 3-13, 16-18, 21, 24, 27-30 and 32-34 under §103(a) over Nicholas in view of Ross. See Office Action, ¶ 2. Applicants respectfully traverse this rejection.

**A Prima Facie Case of Obviousness Has Not Been Made**

It is well settled that the PTO has the burden to establish a *prima facie* case of obviousness. MPEP §2142. “If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” *Id.* Applicants respectfully submit that, even now, the PTO has not established a case of *prima facie* obviousness.

**1. There Is No Teaching To Combine Ross and Nicholas**

There can be no finding of *prima facie* obviousness based upon the combined teachings of prior art references unless there is also some teaching, suggestion, or reason why one of skill in the art would have been made, at the time the invention was made, make the proposed combination. *See e.g., McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000). Such hindsight-based reasoning is “particularly tempting” when the invention and the art is “relatively simple.” *McGinley*, 60 USPQ2d at 1008. Nonetheless, such hindsight-based analysis must be avoided because, as noted by the Federal Circuit, the “genius of invention is often a combination of known elements which in hindsight seems preordained.” *Id.*

In the present case, Ross teaches an airbag that is designed to overcome problems associated with venting an airbag during deployment. More specifically, Ross’ system is designed to ensure that the inflation gas used to expand the airbag does not vent out of the discharge outlets prior to the time that the occupant impacts that airbag. *See e.g., Ross Col. 1, lines 16-45.* Ross addresses this problem by constructing his airbag with two cloth layers that are sewn together along tear seams such that the second layer of cloth operates to seal the discharge openings. *See id.* at Col. 1, line 56- Col. 2, line 13. When Ross’ system is inflated, the tear seams will slowly separate; however, Ross’ airbag is constructed such that in the area proximate to the discharge openings, the tear seams hold the cloth layers together until the tear

seam is completely torn open. *See id.* at Col. 4, lines 45-51; Ross Col. 1, line 56- Col. 2, line 13. Thus, the “discharge openings...remain sealed until the airbag is almost completely inflated, and the gas is prevented from escaping from the airbag...prematurely.” *Id.* at Col. 4, lines 51-54.

Nicholas, on the other hand, teaches a completely distinct invention that is designed to solve a different type of problem. Particularly, Nicholas teaches a multi-leveled trim panel that is used cover the airbag system. *See* Nicholas Col. 2, line 65- Col. 3, line 8. The trim panel includes one or two deployment doors 14 are formed by having a laser or other cutting device form a gap 18 along three peripheral sides of the door 14. *See id.* at Col. 3, lines 9-31. The fourth side of the rectangular door is called the hinge 16 is not weakened or cut using the laser. *See id.* at Col. 2, lines 56-65. When this trim panel is used in an airbag system, the force of the airbag deployment will cause the bag to deploy through the deployment doors 14. *See id.* In other words, when the airbag deploys, the force of the inflating gas will push open the rectangular doors 14—*i.e.*, the doors 14 will swing outwardly along the axis of the hinge 16—so that the airbag can access the interior compartment of the vehicle. *See id.* at Col. 2, lines 57-61.

Accordingly, because Nicholas and Ross teach completely different inventions that solve completely different problems, Applicant believes that there is no reason why a skilled artisan, with no knowledge of Applicants’ invention, would have made the proposed combination of Nicholas and Ross. Thus, the proposed combination of Nicholas and Ross is simply a hindsight-based deconstruction of the present invention that uses Applicants’ own work as the blueprint for piecing together the prior art. As such, this rejection based upon the combined teachings combined teachings of Nicholas and Ross is improper and should be withdrawn.

2. **Nicholas Teaches Away From Applicants’ Invention and From Combination With Ross**

Furthermore, evidence that the cited references teach away from their combination or that the art teaches away from the Applicants’ invention defeats, by itself, any assertion of *prima facie* obviousness. *See e.g., Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000) (“Second, if Johnson [*i.e.*, the Johnson reference] did in fact teach away from Moore [*i.e.*, the Moore reference], then that finding also can defeat Wang’s obviousness

claim”); *see also In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988); *McGinley*, 60 USPQ2d at 1010. Teaching away means teaching “in a direction divergent from the path that was taken by the applicant” and demonstrates nonobviousness. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

In the present case, Nicholas explicitly teaches that the deployment door 14 is “generally rectangular” in shape. *See* Nicholas Col. 2, lines 57-58; Figures 1-2. Of necessity, this teaching means that the “seams” used to form the deployment door 14 are made up of linear, straight segments that are formed into a rectangular shape. *See id.* Applicants submit that this teaching of linear-shaped tear seams directly contradicts and teaches away from both Applicants’ non-linear tear seam invention and from the non-linear tear seams disclosed by Ross. Accordingly, this teaching away defeats, by itself, any claim that the combined teachings of Nicholas and Ross make the present claims *prima facie* obvious. At the very least, this teaching of linear “seams” found in Nicholas is cogent evidence that one of ordinary skill in the art would not have been motivated to combine the teachings of Nicholas and Ross in the manner asserted by the Examiner. Withdrawal of this rejection is respectfully requested.

**3. The Previously Submitted Declaration of Edward Friery Is Probative and Cogent Evidence of Nonobviousness**

In the Office Action, the Examiner acknowledged that the previously submitted declaration of Edward Friery was “sufficient to overcome the rejection [under §103(a)] of relevant claims based upon Yamamoto in view of Nicholas.” Office Action, ¶ 3. Applicants submit that this same declaration (and the evidence contained therein) also overcomes the present rejections based upon Nicholas and Ross.

As explained in the prior Office Action response, the knowledge and belief that existed at the time the invention was made indicated that the use of nonlinear tear seams in airbag covers was inappropriate and would lead to unpredictable positioning of the cushion during deployment. *See* Declaration, ¶ 10 (“In particular, it was believed that upon deployment of the cushion, the cover would tear outside of the nonlinear seam such that the cushion would deploy in an

unpredictable manner.”).<sup>1</sup> Even the inventor’s supervisor, who was a highly trained engineer in the field, believed that the nonlinear seam would produce unfavorable results. *See id.* Such teachings and beliefs in the industry directly taught away from the Applicants’ invention and use of a nonlinear tear seam. This teaching away is further evidence that the present invention is nonobviousness, regardless of the references asserted by the Examiner.

Furthermore, the Declaration also highlights other objective, secondary considerations that show nonobviousness including long-felt need in the art, skepticism of experts in the field, and the repeated failure of others to solve the problem. *See e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871, 879 (Fed. Cir. 1983) (“[S]econdary considerations may often be the most probative and cogent evidence in the record... [and] may often establish that an invention appearing to have been obvious in light of the prior art was not.”). Specifically, the Declaration outlines how Mr. Friery, one of the inventors of the present application, was hired over seven and half years ago to find solutions to the seam “read-through” problem and other problems prevalent in airbag covers. *See Declaration*, ¶ 6. In fact, Mr. Friery has worked on solving the seam “read-through” problem for over five years. *See id.* Mr. Friery still receives telephone calls from associates or foreign counterparts who are seeking a solution to the problem of seam “read-through.” *See id.* at ¶ 13. Prior attempts at solving the seam “read-through” problem involved placing a styling line over the seam; however not only did such solutions fail to resolve this problem, many of these solutions actually seemed to perpetuate the problem. *See id.* at ¶¶ 7-8. Mr. Friery’s approach to this problem was to use a nonlinear tear seam, which ran contrary to the standard in the industry and the belief of Mr. Friery’s own supervisor. *See id.* at ¶ 10. Despite the skepticism of other experts in the field however, this nonlinear tear seam provided an appropriate solution to the seam “read-through” problem. *See id.* at ¶ 11-12.

Accordingly, the present evidence of record, including the teachings of the prior art and the objective secondary considerations, show that the present invention was not obvious in light of any combination of the cited references asserted by the Examiner. Withdrawal of this rejection is respectfully requested.

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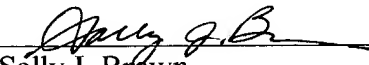
<sup>1</sup> As used herein the term “Declaration” refers to the previously submitted Declaration Under 37 C.F.R. 1.132 that was signed by the co-inventor, Edward Friery. For purposes of brevity, an additional copy of this Declaration has not been attached to the present paper.

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**Conclusion**

In view of the foregoing, the Applicants submit that none of the pending claims can be rejected as obvious to the cited references under § 103(a). Accordingly, the Applicants request that the present claims be immediately allowed. However, if there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

  
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